

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Chin-Ti Chen et al
Serial No. : 09/996,202
Filed : November 28, 2001
Title : OXADIZAOLE TETRAMERS

Art Unit : 1774
Examiner : Camie S. Thompson

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL REPLY TO OFFICE ACTION OF MAY 5, 2004

After receiving an Advisory Action dated August 20, 2004, Applicant scheduled a telephone interview with the Examiner on September 2, 2004. During this interview, the Examiner accepted the amended claims as proposed by the applicant in response to the final Office Action. The decision was based on an e-mail message provided by Applicant prior to the interview, at the Examiner's request. This email provided the reasons for allowance of the amended claims. A copy thereof is attached as "Exhibit A."

Applicant submits that the grounds for rejection asserted by the Examiner have been overcome, and that claims 1-6, 8, 9, 11-18, 20 and 21 as pending, define subject matter that is novel. On this basis, it is submitted that all claims are now in condition for allowance, an action of which is requested.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

September 3, 2004
Date of Deposit

Diane M. Saturno
Signature

Diane M. Saturno
Typed or Printed Name of Person Signing Certificate

Applicant : Chin-Ti Chen et al
Serial No. : 09/996,202
Filed : November 28, 2001
Page : 2 of 2

Attorney's Docket No.: 08919-053001 / 03A-890425

Please apply any other charges or credits to deposit account 06-1050, referencing
Attorney's Docket No. 08919-053001.

Respectfully submitted,

Date: _____

9-3-04



Y. Rocky Tsao Ph.D., J.D.
Attorney for Applicants
Reg. No. 34,053

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

Rocky Tsao

From: Rocky Tsao
Sent: Wednesday, September 01, 2004 6:56 PM
To: 'camie.thompson@uspto.gov'
Subject: Outline for Telephone interview (U.S. Application No.: 09/996,202; Our Ref.: 08919-053001)

Dear Examiner Thompson,

Thank you for granting a telephone interview for 3 pm tomorrow. Below are the two issues we would like to discuss with you during the telephone interview:

1. Indeed, the proposed amendment of claims 1, 4, 5 and 11 narrows the scope of these claims. However, these amended, narrower claims would not necessitate additional search. The compounds covered by these narrow claims are a subset of the compounds covered by the original broader version of these claims. As a matter of fact, the earlier search was already aimed at the compounds covered by these narrow claims.
2. WO 00/03565 discloses a compound in which D is nitrogen, B is carbon, A is oxygen, and R5 is a t-butylphenyl group. In the closest compounds covered by the pending claims, D is nitrogen, B is carbon, A is oxygen and R5 is alkylaryl in which the aryl moiety is substituted with one or more C₁₋₆ alkyl groups further substituted with hydroxyl, protected hydroxyl, amino, protected amino, carboxy, protected carboxy, alkoxy, halo, CN, or NO₂. Note that R5 is a substituted alkylaryl with the substituents clearly defined to not include the t-butylphenyl group. Thus, contrary to your belief, these compounds are not anticipated by WO00/03565.

I look forward to our discussion tomorrow.

Regards,

Rocky Tsao
Registration No. 34,053